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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,484	09/04/2003	Takayuki Ogino	9333/353	5870

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ALPINE/BHGL
P.O. Box 10395
Chicago, IL 60610

EXAMINER

RATHINASAMY, PALANI P

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/655,484	Applicant(s) OGINO ET AL.	
	Examiner Palani P. Rathinasamy	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/4/2003, 6/4/2007</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed 6/4/2007 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

3. Claims 8-10 are rejected as method steps within a system claim. System claims specify the physical structure required to perform the method steps. In addition, these claims specify the functionality of various parts of the system. However, claims 8-10 are objected to because they describe method steps rather than the apparatus required to perform the method.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 4. Claims 1-4, 11-13, 16, and 18-20, are rejected under 35 U.S.C. 102(b) as being anticipated by Wilkman (US 2002/0013728 A1).**
5. Regarding claims 1, 11, and 16, Wilkman teaches of a system and method “for providing transaction control for purchasing decisions that involve the use of credits, debits, loyalty points, affinity points, promotions, or currency transfers.” (Abstract). In particular, Wilkman teaches of obtaining user information (Fig. 5; [0102]-[0106]) and loyalty information related to the user ([0066]; [0110]). Thereafter, a query is done for merchants who satisfy various factors, one of which is number of loyalty points. ([0110]; [0113]). The system then displays merchant information and their related promotion for merchants that match the criteria (i.e. number of points). ([0116]-[0118]).
6. Regarding claims 2, 12, and 18, Wilkman teaches that the user can click on a promotion to find detailed information about the merchant, such as “driving distance, travel time, photo of location, photo of building, sample menu, list of prices, dining ratings, and so forth.” ([0118]; [0129]).
7. Regarding claim 3-4, 13, 19-20, Wilkman teaches of storing promotion information related to merchants in a searchable database accessible to the user.

([0063], [0064]). Wilkman further teaches that the user can search and sort merchants and promotions based on the "number of loyalty points". ([0110], [0113]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-6, 14-15, and 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Smith (US 6,314,365).

9. Regarding claims 5-6, 14-15, and 17, as stated above, Wilkman teaches of a system and method for a user being able to search for merchants that satisfy a certain requirement, such as loyalty points. (Wilkman, [0110]; [0113]). Wilkman teaches that a user can select a specific merchant/promotion in order to find further details related to that merchant/promotion. (Wilkman, [0118]). Furthermore, Wilkman explicitly teaches of a "map feature that presents the user with a map of the location of the service as well as other information." (Wilkman, [0129]). Additionally, Wilkman teaches that the system can be used on any portable device, such as a cell phone or personal digital assistant (PDA).

Wilkman does not explicitly teach of the system providing guidance by guiding a vehicle to the merchant. However, Smith teaches of a system *and method for providing guidance to a vehicle using a users cell phone. (Smith, Abstract). In

particular, Smith teaches that the user enters a destination into the cell phone (merchant destination) and the cell phone provides directions and a map to the user in a vehicle. (Smith, Fig. 1; Col 1, Lines 65-67; Col 2, Lines 1-61). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's teaching of a system on a cell phone for providing merchant information (including a map) based on a user's query with Smith's teaching of a cell phone that is used to navigate a vehicle to a desired location. One would have been motivated to do so because a navigational system is a known upgrade to a map based directional system.

10. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Mizuishi et al. (JP 2002230696 A -- 8/16/2002).

11. Regarding claims 7-10, Wilkman teaches of a system and method whereby a user enters in personal information, searches for a merchant/promotion based on various factors, is displayed a list of eligible merchants, and is given subsequent information related to merchant/promotion. (Wilkman, Abstract; [0110]; [0113]; [0118]; [0129]). Furthermore, Wilkman teaches that the system manages, tracks, and grants reward points. (Wilkman, [0110]; [0125]-[0126]).

Wilkman does not explicitly teach of awarding points to a user based on their driving activities. However, Mizuishi et al. teaches of a system and method for awarding points to a user based on characteristics of their actual driving. (Abstract). Therefore, it

would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's point management system with Mizuishi et al.'s teaching of awarding points based on driving. One would have been motivated to combine the references because Wilkman teaches of a method for managing points while Mizuishi et al. teaches of a method for obtaining points.

Conclusion

Examiner's Note: Examiner has cited particular columns, line numbers, and paragraphs in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing responses, fully consider each of the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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ARTHUR DURAN
PRIMARY EXAMINER